

## REMARKS/ARGUMENTS

Claims 1-11 stand rejected under 35 USC 101. The Examiner asserts the claimed invention is directed to non-statutory subject matter; the claims recite “mathematical algorithm and abstract ideas without any limitation to a tangible and concrete result(s). The training is mental training.”

Claims 12-17 are new in this response and are included to further refine the claimed invention.

Applicant respectfully submits the Examiner’s rejection is not sufficient under MPEP 2106 which states, “Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 USC 101.” The MPEP goes on to explicitly state the Examiner “must expressly state how the language of the claim has been interpreted to support the rejection.” Applicant respectfully submits the Examiner’s September 22 office action does not comply with MPEP 2106.

MPEP 2106 controls examination of application for letters patent on computer-related inventions. Generally the claims for computer-related inventions as well as methods of doing business should be treated like any other process claims, with the test for patentability being whether the claimed invention produces a “useful, concrete and tangible result.” *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596, 1601-1602 (Fed. Cir. 1998).

To avoid the difficulty Office personnel previously encountered in properly treating method claims, the MPEP requires the Examiner to “establish a *prima facie* case that the claimed

invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.”

Under the *State Street* test, Applicant respectfully suggests the claims should be construed so as to produce the useful, concrete and tangible results required to be statutory subject matter under 35 USC §101. Specifically, the application claims training that occurs outside a computer, a lesson-plan matrix for integrating the training into the environment or curriculum, activities that occurs in a computer, and an evaluation based on success of the training, the concrete and tangible results of the training and integration of the training. Computer output is commonly considered concrete and tangible results. MPEP 2106.

Furthermore, Applicant respectfully suggests the claimed limitation “providing evaluation of the success of the training” is a physical act that occurs outside the computer, and thus falls within the safe harbor of statutory process claims. See MPEP 2106. The evaluation is a physical act that provides the professional with information helpful in evaluating the effectiveness of the lesson plan. This type of ‘outside the computer’ activity is the type of activity MPEP 2106 requires for a method or system claim to be statutory under 35 USC §101.

In both the first and second Office actions, the Examiner’s comments were limited to cursorily stating “Claims 1-11 are directed to a mathematical algorithm without any limitation to provide tangible and concrete results” (see the Examiner’s first Office action), with the second Office action added, “The training is mental training (see figure 1).” Applicant respectfully submits the Examiner’s response does not comply with the requirements of MPEP 2106 because the Examiner failed to “expressly state how the language of the claims has been interpreted to

support the rejection.” Applicant respectfully requests the Examiner reconsider the application in light of the MPEP’s instruction.

MPEP 2106 II A goes on to say, “Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 USC 101. [Therefore,] Office personnel should focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. Only one practical application is necessary...”

Applicant respectfully submits the application’s claims should be construed to contain the limitation professional development, such as improving a teacher’s effectiveness, and maximizing students’ ability to learn. This limitation is an application in the technological art of pedagogy.

Furthermore, Applicant respectfully submits the Examiner has not complied with the requirements set forth in the MPEP because the Examiner has not identified the claimed invention’s statement of application in the technological arts and how those statements comply with the statutory criteria. The Office actions failure to comply with the MPEP requirements requires the Examiner to reconsider the application.

The MPEP 2106 II B further states, “Office personnel should begin their evaluation of a computer-related invention[’s] [detailed disclosure] as follows: (1) determine what the programmed computer does when it performs the process by the software...Of importance is the significance of the data and their manipulation in the real world.” Citing *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053, 1057, 22 USPQ2d 1033, 1036 (Fed. Cir. 1992). (2) determine how the computer is to be configured to provide that functionality. (3) ...determine the relationship of the programmed computer to other subject matter outside the computer that

constitutes the invention.” This process is critical to aid the Examiner in understanding the scope of the claimed invention and its application.

Applicant respectfully submits that the Examiner has not complied with the three steps outlined above, namely, he has not determined the functionality and the configuration of the computer program and how that program supports the user of the claimed invention. Applicant further submits the claimed invention teaches a configuration that provides a functional invention with the required relationship between the programmed computer and other subject matter outside the computer. Applicant respectfully requests the Examiner comply with the three steps outlined above (see MPEP 2106 II B) and reconsider the rejection.

MPEP 2106 II C next requires the Examiner to review the claims of the present invention. It states,

Office personnel must first determine the scope of the claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. Office personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all circumstances. The correlation step will ensure that Office personnel interpret each claim limitation.

The thorough analysis required by the Office ensures the Examiner correctly identifies statutory subject matter and the scope of the claims claiming that matter.

Applicant respectfully submits the Examiner did not comply with the steps described in MPEP 2106 II A and B, and thus it is impossible to correlate the findings of

AB with claims, as required by C. Applicant again requests the Examiner reconsider the appropriateness of rejecting the present invention on 35 USC 101 grounds; when the requirements of MPEP 2106 are followed, it will be clear the invention teaches and claims statutory matter.

MPEP 2106 IV B 2 b entitled “Statutory Process Claims” states that one type of statutory process claim is where the computer-related process results in a physical transformation outside the computer for which there is a practical application. “If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention … is sufficient.” Furthermore, where “a process claim includes one or more post-computer process steps that result in a physical transformation outside the computer, the claim is clearly statutory.”

Applicant respectfully submits the claims of the present application should be construed to recognize three separate computer-related activities: pre-computer training, computer related matrix and worksheets, and post-computer evaluations. The acts outside the computer make the claimed process statutory according to MPEP 2106.

## CONCLUSION

Based on the foregoing, Applicant submits that the claims are now in condition for allowance and respectfully requests the same. If any impediments to the allowance of this application remain after consideration of the foregoing remarks, the Examiner is invited to initiate a telephone conference with the undersigned counsel of record.

Dated this 11 day of November, 2004.

Respectfully submitted,

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